



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,959	05/24/2000	David I. Durst	TDT-207	6121

7590 10/03/2005

Steven M. Hoffberg, Esq.
MILDE, HOFFBERG & MACKLIN, LLP
Suite 460
10 Bank Street
White Plains, NY 10606

EXAMINER

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,959

Applicant(s)

DURST ET AL.

Examiner

Grigory Gurshman

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-28, 35-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

AT

DETAILED ACTION

Response to Arguments

1. In response to the election/restriction requirements under 35 U.S.C. 121, Applicant has withdrawn the claims 1-7, 9-13 (Group I), and claims 14-17, 31-34 (Group IV), and claims 8, 29, 30 (Group II). Applicant has filed the new claims 35-45.
2. Applicant has elected the claims 18-21 of Group III with traverse to extend that these claims are entitled to be prosecuted with claims 22-28 as amended. Applicant has also stated that the substantial elements of claim 18 have been included in new claims 35-40, and therefore all of the claim 18-21, 22-28 and 35-40 now belong to the same Group III.
3. Examiner finds Applicant's grouping of the claims inappropriate for the following reasons:

Claims 18 – 21 and 43-45 are, drawn to an optically readable data storage medium, classified in class 360, subclass 133.

Claims 22-28 are drawn to a system for reading an optically readable data storage medium comprising **an optical disc reader**, classified in class 235, subclass 454.

Claims 35-42 are drawn to an authentication system comprising in essence the elements of the optical disc reader.

Art Unit: 2132

4. In view of the reasons presented herein, Examiner finds that further restriction to one of the following inventions is required under 35 U.S.C. 121.

Election/Restrictions

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 18 – 21 and 43-45 are, drawn to an optically readable data storage medium, classified in class 360, subclass 133.

Group II: Claims 22-28 and 35-42 are drawn to a system for reading an optically readable data storage medium comprising **an optical disc reader**, classified in class 235, subclass 454.

6. Reasons for restriction are as follows:

6.a The claims 18-21 and 43-45 of Group-I are drawn to an *optical disc*. The claims 22-28 and 35-42 of Group-II are drawn to an *optical disc reader*.

Inventions Group-I and Group-II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group-I has separate utility such as reading various optical discs, not just the one claimed by Group-II. See MPEP § 806.05(d).

6.b The claims of Group-I are classified in class 360/ 133 and the claims of

Art Unit: 2132

Group-II are classified in class 235/ 454. Accordingly the claims as grouped above will require a different filed of search. Further more an optical disc reader is an apparatus while an optical disk is a storage medium, therefore claims as grouped have a different status in the art.

7. Newly submitted claim 43-45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

43-45 are, drawn to an optically readable data storage medium, classified in class 360, subclass 133 while the original claims 22-28 and 35-42 are drawn to a system for reading an optically readable data storage medium comprising **an optical disc reader**, classified in class 235, subclass 454

8. Applicant has elected claims 18-21. Claims 43-45 belong to the same Group based on the reasons provided in § 5 of the instant Office Action. Therefore, claims 18-21 and claims 43-45 are examined herein.

9. Applicant's traverse is not persuasive because claim 21 is drawn not to a particular one of optical storage mediums, which is not required for the particular one of optical disc readers.

However, if claim 21 is determine do be allowable claim 22 will be rejoined with the examined claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18-21 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (U.S. Patent No. 5,549,953) in view of Waters (U.S. Patent No. 5,572,589).

12. Referring to the instant claims, Li discloses an optical recording media having optically variable security properties (see abstract and Fig.1). In Fig. 26 Li show the pattern applied to the recording medium. Li teaches that the position of the reflection peaks (i.e. pattern) depends on the phase thickness, which is given by equation 1 (see column 6). Equation produces a cipher, which defines the pattern on the recording medium. The produced cipher meets the limitation "hash being formed from a respective data pattern". Li, however, does not explicitly teach that the data pattern is created on the disc in a form of random fiber or molded pattern.

13. Referring to the instant claims, Waters discloses a method for minimizing counterfeiting of CD-ROMs and authenticating users of CD-ROMs. In accordance with the first aspect of the present invention, a method of serializing a disc involves physically damaging a portion of the disc to create a pattern of damage. The pattern of damage is encoded in an identifying value and the disc is marked with the identifying

Art Unit: 2132

value to distinguish the disc from other discs (see column 1, lines 25-35). Walters also teaches authenticating the disc based on the pattern (see Fig. 9).

14. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to create the optical recording media having optically variable security properties of Li, by damaging (i.e. changing) the fiber pattern of the optical disc as taught in Walters. One of ordinary skill in the art would have been motivated to create the optical recording media having optically variable security properties of Li, by changing the fiber pattern of the optical disc as taught in Walters for authenticating the disc based on the pattern (see Walters, column 1, lines 25-35 and Fig. 9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GG

GG

Grigory Gurshman
Examiner
Art Unit 2132

Gilberto Jr.

GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100